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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/506,767	02/18/2000	Craig A. Link	MFCP.68211	8104

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INTELLECTUAL PROPERTY DEPARTMENT
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EXAMINER

AKINTOLA, OLABODE

ART UNIT	PAPER NUMBER
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3691

MAIL DATE	DELIVERY MODE
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07/13/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/506,767

Applicant(s)

LINK ET AL.

Examiner

Olabode Akintola

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 30 is/are allowed.
- 6) ☒ Claim(s) 1-29 and 31-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The declaration filed on 11/1/2006 under 37 CFR 1.131 has been considered but is ineffective to overcome the Mann and Nesbitt references.

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the these references.

A general allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131.

37 CFR 1.131(b) requires that original exhibits of drawings or records, or photocopies thereof, accompany and form part of the affidavit or declaration or their absence satisfactorily explained. The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice “amounts essentially to mere pleading, unsupported by proof or a showing of facts” and, thus, does not satisfy the requirements of 37 CFR 1.131(b). *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ

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164 (CCPA 1964) (Affidavit “asserts that facts exist but does not tell what they are or when they occurred.”). See MPEP 715.07 “Facts and Documentary Evidence”. In the instant case, the scope of the declaration/exhibit is not commensurate with the scope of the claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-6, 8, 11, 15-16, 24-28, 31-32, 34, 38 and 40-44 are rejected under 35

U.S.C. 103(a) as being unpatentable over Mann et al (USPN 6298341) (“Mann”) in view of Nesbitt (Web e-mail services) (“Nesbitt”).

Re claims 1, 16, 24-27, 31-32, 34, 38 and 40: Mann teaches a method of producing a unique modified account name based on a requested account name that has been determined to already

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exist, the method comprising: receiving a requested account name from a user (col. 3, line 40-col. 4, line 39; Fig 3A (S3-3)); selecting a preexisting word element from at least one preexisting list of word elements (col. 4, lines 55-67; Fig 3A (S3-5)); combining the preexisting word element and at least a stem of the requested account name to produce a modified account name (col. 4, line 55-67; Fig 3A (S3-5)); comparing the modified account name with a list of existing account names to determine whether the modified account name is unique (col. 5, line 25-33; Fig 3A-3B (S3-7)); and, if the modified account name is unique, providing the modified account name to the user for acceptance (col. 4, lines 30-39).

Mann does not explicitly teach an account name. Nesbitt teaches account name (page 1, "A few basics"). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Mann to include account name. One would have been motivated to do so in order to provide a list of alternative names to the requestor.

Re claims 2-5, 11 and 41-44: Mann teaches wherein the preexisting word element is randomly selected from the at least one preexisting list of word elements (col. 4, lines 30-39; Fig 3A (S3-3)).

Re claims 6, 8, 15, and 28: Mann teaches the limitations of claim 6, except for using numerical seed. However, Mann explicitly teaches the use of any character such as hyphens or any other account permitted strings and characters (Col. 5, lines 4-11). It would have been obvious to one

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of ordinary skill in the art at the time of the invention to modify Mann to include numerical seed. One would have been motivated to do so in order to allow for greater flexibility.

Claims 7, 9-10, 12-14, 17-23, 29-30, 33 and 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mann in view of Nesbitt and further in view of Blinne (USPN 5995730) ("Blinne").

Re claim 7 and 9-10: Mann does not explicitly teach incrementing a numerical seed by one if the account name is not unique. Blinne teaches this limitation (abstract). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Mann to include this feature as taught by Blinne. One would have been motivated to do so in order to modify the account name to satisfy a set of rules until uniqueness is achieved.

Re claims 12-14 and 45-46: Blinne further teaches if the modified account name is not unique, the operations producing the unique modified account name are repeated on an iterative basis until a unique modified account name is produced (abstract). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Mann to include this feature as taught by Blinne. One would have been motivated to do so in order to modify the account name to satisfy a set of rules until uniqueness is achieved.

Blinne does not explicitly teach predetermined number of iterations. Official notice is hereby taken that this feature is old and well known. It would have been obvious to one of ordinary skill

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in the art at the time of the invention to modify Mann to include this feature. One would have been motivated to do so in order to avoiding endless cycle of iteration, thereby saving time.

Re claim 17-23, 29-30, and 33: See claim 1 analysis above. Mann teaches the limitations of claims 17-20 except combining a first (adjective) and second (noun) word elements to produce a random account. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Mann to include noun phrase (such as myfriendtax.com or myfriend-tax.com) to the invention as a matter of design choice, thereby providing wider range of selectable choices to the requestor (col. 5, lines 4-11 and col. 7, lines 13-21)

Claims 35-37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mann in view of Nesbitt in view of Blinne and further in view of Johnson ("How To...Install and Begin Using American Online", 05/1997) ("Johnson").

Re claims 35-37 and 39: Mann does not explicitly teach receiving an alternate requested account name from the user. Johnson teaches this limitation (page 4 paragraph 5). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Mann to include this feature. One would have been motivated to do so in order to give the requestor a predetermined number of chances to create their account names before suggesting one for the requestor.

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Allowable Subject Matter

Claim 30 is allowed.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Heidorn et al (USPN 5966686) combining an adjective and a noun to construct a noun phrase (col. 4, lines 1-7).

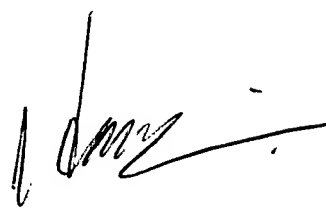
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olabode Akintola whose telephone number is 571-272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OA



HANI M. KAZIMI
PRIMARY EXAMINER